

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

At the outset, Applicants note with appreciation the indication that claims 7-16 and 18 would be allowable if rewritten in independent form including all of the features of the base claim and any intervening claims (Official Action at page 10).

By the above amendments, claims 1 and 23 have been canceled without prejudice or disclaimer. Claim 6 has been amended to be in independent form, and to add a period at the end of such claim. Claims 2-5, 14 and 17-19 have been amended to depend from claim 6. Claim 7 has been amended for readability purposes to recite the entire formula of the alignment promoter. Claim 20 has been amended for readability purposes by replacing in one instance the word "or" with "and".

New independent claim 24 is directed to the subject matter of original claim 7. New dependent claims 25-36 directly or indirectly depend from claim 24, and are directed to the subject matter of original claims 2-4, 8-13 and 17-19, respectively. New independent claim 37 is directed to the subject matter of original claim 14. New claims 38-46 depend from claim 37, and are directed to the subject matter of original claims 2-5 and 15-19, respectively. New independent claim 47 is directed to the subject matter of original claim 18. New claims 48-52 depend from claim 47, and are directed to the subject matter of original claims 2-5 and 19, respectively.

As discussed above, the Patent Office has indicated that claims 7, 14 and 18 contain allowable subject matter. As also discussed above, new independent claims 24, 37 and 47 correspond to the subject matter of original claims 7, 14 and 18, respectively. For at least this

reason, it is believed that new claims 24-52 are in condition for allowance, and indication of the allowance of such claims is respectfully requested.

The Official Action at page 2 states that copies of some of the documents cited in the Information Disclosure Statement (IDS) filed January 21, 2003, have not been received by the Patent Office. However, Applicants respectfully note that a copy of each document cited in such IDS was filed together with the IDS. In this regard, attached is a copy of a PTO-stamped postcard which acknowledges the Patent Office's receipt of all nine documents cited in the IDS.

For the Examiner's convenience, attached are duplicate copies of the previously cited EP 0 928 984 A2, GB 1 455 442, WO 00/04110 A1 and EPO Search Report, as well as a supplemental form PTO-1449 citing such documents. Consideration of such documents and issuance of an Examiner-initialed form PTO-1449 is respectfully requested.

Claims 1-22 have been objected to for the reasons set forth at pages 2 and 3 of the Official Action. This objection has been obviated by the above amendments in which claim 1 has been canceled and claim 20 has been amended by replacing the objected-to word "or" with "and". Accordingly, withdrawal of the above objection is respectfully requested.

In response to the Examiner's claim language suggestions set forth at pages 3 and 4 of the Official Action, claim 7 has been amended for readability purposes to recite the formula "(Hb-L¹-Cy¹-L²-)_nCy²".

Claims 1-5, 17 and 19 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,245,398 (hereinafter "the '398 patent"). Without addressing the propriety of the Examiner's comments regarding the '398 patent, it is noted that this rejection is moot in light of the above cancellation of claim 1, and the above amendments of claims 2-5, 17 and 19 to depend from claim 6. In this regard, it is noted that claim 6 has not been rejected in the

present §102(e) rejection. Accordingly, for at least the above reasons, withdrawal of the above rejection is respectfully requested.

Claim 6 stands rejected under 35 U.S.C. §102(e) as being anticipated by the '398 patent and U.S. Patent No. 6,338,808 (hereinafter "the '808 patent"). Withdrawal of this rejection is respectfully requested for at least the following reasons.

As acknowledged at page 7 of the Official Action, the '398 patent does not explicitly disclose an alignment promoter represented by the formula (I) in which B1 is an n-valent group showing an excluded volume effect, as recited in claim 6. Moreover, the Patent Office has not established with the requisite certainty that the structure illustrated at page 7 of the Official Action, shows an excluded volume effect.

In this regard, the legal standard for inherency is well established. In order for prior art to anticipate a claimed invention, the inherency must be certain. Ex parte Cyba, 155 USPQ 756 (POBA 1966). The fact that a prior art article "may" inherently have the characteristics of the claimed product is not sufficient. Ex parte Skinner, 2 USPQ2d 1788 (BPAI 1986). Inherency must be a necessary result and not merely a possible result. In re Oelrich, 212 USPQ 323 (CCPA 1981). Moreover, the Patent Office must provide some evidence or scientific reasoning to establish the reasonableness of such belief before Applicants can be put through the burden of demonstrating that the subject matter of the prior art does not possess the characteristics relied upon. Ex parte Skinner, 2 USPQ2d 1788, 1789 (BOPA 1986).

Here, the Patent Office has not established inherency of Applicants' claimed feature with the requisite certainty. In this regard, the Patent Office has relied on the '808 patent for establishing that the structure illustrated at page 7 of the Official Action, shows an excluded volume effect. However, the '808 patent does not disclose that the structure illustrated at

page 7 of the Official Action (which does not contain five –OCH₃ groups) shows an excluded volume effect. Rather, the '808 patent discloses that Example Bu-6 (which contains five –OCH₃ groups) shows an excluded volume effect (col. 6, lines 1-14). Simply put, the Patent Office has not provided any reasoning or scientific evidence which establishes with the requisite certainty, that the structure illustrated at page 7 of the Official Action itself shows an excluded volume effect.

Furthermore, the disclosure of Example Bu-6 by the '808 patent does not qualify as §102(e) prior art against the present application. In this regard, the attached Declaration Under 37 C.F.R. §1.132 executed by Mitsuyoshi Ichihashi, Ken Kawata, Hiroshi Takeuchi and Koushin Matsuoka, states that the above declarants are the inventors of the Example Bu-6 disclosed in the '808 patent.¹ In addition, the attached Declaration Under 37 C.F.R. §1.132 executed by Ken Kawata, Shigeki Yokoyama, Mitsuyoshi Ichihashi, Koushin Matsuoka and Hiroshi Takeuchi, is executed by the inventors listed on the face of the '808 patent. This declaration states that the inventors of the present application, i.e., Mitsuyoshi Ichihashi, Ken Kawata, Hiroshi Takeuchi and Koushin Matsuoka, are the inventors of the Example Bu-6 disclosed in the '808 patent. The above Declarations show that the Example Bu-6 disclosed in the '808 patent is not by "another". Accordingly, such disclosure of the '808 patent is removed from qualifying as §102(e) prior art against the present application. See M.P.E.P. §§706.02(b) and 716.10.

For at least the above reasons, it is apparent that the '398 patent does not constitute an anticipation of one aspect defined by claim 6. Accordingly, withdrawal of the above §102(e) rejection is respectfully requested.

¹ The above declarants are the same as the inventors of the present application, i.e., Mitsuyoshi Ichihashi, Ken Kawata, Hiroshi Takeuchi and Koushin Matsuoka.

Claims 20-22 stand rejected under 35 U.S.C. §103(a) as being obvious over the '398 patent in view of the '808 patent. Withdrawal of this rejection is respectfully requested for at least the following reasons.

The '398 patent does not disclose or suggest each feature of one aspect as defined by claim 20. For example, as acknowledged at page 8 of the Official Action, the '398 patent fails to disclose or suggest a liquid crystal layer which contains an alignment promoter represented by the formula (I) in an amount of 0.005 to 0.5 g/m², as recited in claim 20.

The Patent Office has relied on the '808 patent for curing the above-described deficiency of the '398 patent. However, under the provisions of 35 U.S.C. §103(c), the submission of the attached Statement Under 35 U.S.C. §103(c) is effective to remove the '808 patent from qualifying as §102(e) prior art in the present §103(a) rejection.² In this regard, the Statement sets forth that at the time the invention of the above-identified application was made, the invention of the above-identified application and the '808 patent, were owned by or subject to an obligation of assignment to Fuji Photo Film Co., Ltd.

Furthermore, as discussed above, the attached §1.132 Declarations show that Example Bu-6 disclosed in the '808 patent is not "by another", and as such, does not qualify as §102(e) prior art against the present application.

For at least the above reasons, it is apparent that no *prima facie* case of obviousness has been established with respect to claims 20-22. Accordingly, withdrawal of the above §103(a) rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

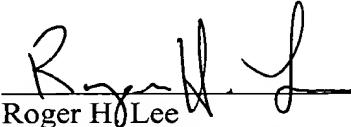
² The Statement Under 35 U.S.C. §103(c) has been executed by Platon N. Mandros, an attorney of record in the present application. See the Combined Declaration and Power of Attorney for Utility Patent Application filed July 6, 2001.

If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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